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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,482	03/21/2007	Stefan Hofmair	001800-68	3588
78198 7590 08/04/2010 Studebaker & Brackett PC One Fountain Square 11911 Freedom Drive, Suite 750 Reston, VA 20190				
EXAMINER				
CHOI, PETER Y				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/581,482

Applicant(s)

HOFMAIR ET AL.

Examiner

PETER Y. CHOI

Art Unit

1786

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-24 is/are pending in the application.
- 4a) Of the above claim(s) 17-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on March 18, 2010, has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5, 7, 10, 15, and 16 are rejected under 35 U.S.C. 103(a) as obvious over USPN 5,982,284 to Baldwin in view of USPN 5,583,489 to Loemker.

Regarding claims 1-3, 5, 7, 10, 15, and 16, Baldwin teaches a textile label featuring a base layer, a transponder arrangement that is bonded to the base layer by a first adhesive layer, a second adhesive layer, and an additional layer including an upper label bonded to the remainder of the label by the second adhesive layer, wherein the transponder arrangement includes an antenna and at least one electronic component that is sealed by the first and the second adhesive layer, and wherein the transponder arrangement is embedded between the first adhesive layer and the second adhesive layer and is in continuous contact with the first adhesive layer and the

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second adhesive layer (Baldwin, column 1 line 14 to column 2 line 59, column 3 line 6 to column 5 line 48).

Regarding claims 1-3, 5, 7, 10, 15, and 16, the prior art appears to teach that the base layer is a textile base layer and the additional layer is a textile layer, as paper appears to be within the scope of a textile base layer, and as it is a non-woven structure made of fibers. However, the prior art does not appear to specifically teach that at least one electronic component is sealed against environmental influences.

Loemker teaches a substantially similar security label which is attached to a garment, the security label comprising a security device between first and second fabric materials, wherein the security label is heat sealed for completely enclosing the security device (Loemker, column 1 line 10 to column 2 line 56, column 4 line 48 to column 10 line 26, claims 1-19). Loemker teaches that the security label is made with fabric material to provide a water tight pocket to protect the security device from damage or rust, and to prevent the user from coming in direct contact with the security device. Loemker teaches that the security label may contain information, the type of garment material, size, and/or brand name. It would have been obvious to one of ordinary skill in the security label art at the time the invention was made to form the security label of the prior art, wherein the base layer and additional layer comprise fabric layers which are sealed for completely enclosing the security device, as taught by Loemker, motivated by the desire of forming a conventional security label with materials known in the art as being predictably suitable for forming security labels which can be attached to garments and which provide a water tight pocket to protect the security device from damage or rust, and to prevent the user from coming in direct contact with the security device.

Regarding claim 2, the prior art teaches that at least one electronic component includes a chip (Baldwin, column 5 lines 38-48).

Regarding claim 3, the prior art teaches that the second adhesive layer extends over the entire transponder arrangement in a plane fashion (Baldwin, Figures 1-4).

Regarding claim 5, the prior art teaches that the second adhesive layer consists of a hot-melt adhesive (Baldwin, column 3 line 58 to column 4 line 5).

Regarding claim 7, the prior art teaches that the base layer features at least one of the group including graphic and alphanumeric symbols (Baldwin, column 1 lines 14-55).

Regarding claim 10, the prior art teaches that the upper label features at least one of the group including graphic and alphanumeric symbols (Baldwin, column 1 lines 14-55).

Regarding claim 15, the prior art teaches that the additional textile layer includes part of a garment (Baldwin, column 6 lines 11-19). Since the label is attached to a garment, the label including the additional textile layer appears to be within the scope of the claimed limitation as being part of a garment. Additionally, it would have been obvious to one of ordinary skill in the security label art at the time the invention was made to form the security label of the prior art, wherein the additional layer includes part of a garment, motivated by the desire of forming a conventional security label which is securely attached to a garment, such that the security label is integrally formed as part of a garment to ease in manufacturing, and such that the security label is difficult to remove.

Regarding claim 16, the prior art teaches a garment featuring a label according to claim 1 (Baldwin, column 6 lines 11-15, claims 18-32).

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin in view of Loemker, as applied to claims 1-3, 5, 7, 10, 15, and 16 above, USPN 4,783,646 to Matsuzaki.

Regarding claim 4, the prior art does not appear to teach that the first adhesive layer consists of a polyester adhesive. However, Matsuzaki teaches a substantially similar identification label to be attached to an article, the label comprising a transponder and multiple layers of adhesive, wherein the adhesives comprise a polyester adhesive (Matsuzaki, column 1 line 6 to column 3 line 27, column 3 line 50 to column 6 line 27). Matsuzaki teaches that polyester adhesives are used to form a surface flatness suitable for printing an article name or the like. It would have been obvious to one of ordinary skill in the identification label art at the time the invention was made to form the identification label of the prior art, wherein the adhesives comprise the polyester adhesive as taught by Matsuzaki, motivated by the desire of forming a conventional identification label with adhesives known in the art to be predictably suitable for use in identification labels, to form a surface flatness suitable for printing an article name or the like.

5. Claims 6 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin in view of Loemker, as applied to claims 1-3, 5, 7, 10, 15, and 16 above, and further in view of WO 01/75843 to Tirkkonen.

Regarding claim 6, the prior art teaches a radio frequency identification device including a foil antenna coil and an integrated circuit. However, the prior art does not appear to teach that the antenna consists at least predominantly of copper. Since the prior art is silent as to the composition of the radio frequency identification device, it would have been necessary and

therefore obvious to look to the prior art for conventional compositions of radio frequency identification devices.

Tirkkonen provides this conventional teaching, showing that it is known in the identification label art to form a substantially similar identification label for use on garments, the label comprising a transponder and multiple layers of adhesive, wherein the transponder comprises a radio frequency identification device formed from copper wire (Tirkkonen, page 1 line 1 to page 4 line 20, page 4 line 36 to page 8 line 13, Figures 1-8).

It would have been obvious to one of ordinary skill in the identification label art at the time the invention was made to form the identification label of the prior art, such that the foil antenna coil of the radio frequency identification device comprises copper, as taught by Tirkkonen, motivated by the desire of forming a conventional identification label formed from metals known in the art to be predictably suitable for radio frequency identification devices.

Regarding claims 11-14, the prior art teaches that the label may be applied to a product by conventional methods. However, the prior art does not appear to teach that the upper layer protrudes over the base layer on at least one side, that at least a portion of the region of the upper label that protrudes over the base layer can be separated from the remainder of the label, and that the region of the upper label that protrudes over the base layer is sewn and/or bonded to a garment. Since the prior art is silent as to the method of attaching the label to a garment, it would have been necessary and therefore obvious to look to the prior art for conventional methods of attaching labels to garments.

Tirkkonen provides this conventional teaching, showing that it is known in the identification label art to form a substantially similar identification label for use on garments, the label comprising a transponder and multiple layers of adhesive, wherein at least a portion of a textile layer protrudes over the remaining portion of the layer (as shown in Figures 5-7 of Tirkkonen), such that the label is attached at its edges by sewing or gluing to a product (Tirkkonen, page 1 line 1 to page 4 line 20, page 4 line 36 to page 8 line 13, Figures 1-8).

It would have been obvious to one of ordinary skill in the identification label art at the time the invention was made to form the identification label of the prior art, such that a portion of a textile layer protrudes over the base layer to be sewn or glued to a garment, as taught by Tirkkonen, motivated by the desire of forming a conventional identification label with conventional attaching methods known in the art to be predictably suitable for attaching identification labels to products such as garments.

Response to Arguments

6. Applicants' arguments filed March 18, 2010, have been fully considered but they are not persuasive. Applicants argue that Baldwin requires an air gap arranged around the perimeter of the RFID chip, and therefore, the RFID chip is not embedded between two adhesive layers and is in continuous contact with each of the adhesive layers. Examiner respectfully disagrees. As shown in at least Figure 1 of Baldwin, 22 represents an electronic device such as an RFID, which is in continuous contact with 32 and 18, wherein 32 represents a first adhesive layer and 18 represents a second adhesive layer. Additionally, although Applicants are entitled to be their own lexicographer, Applicants have not defined, for example, "embedded" with any objective

and/or quantitative characteristics. Therefore, the scope of “embedded” incorporates the plain meaning of “embedded,” which includes surrounding, enveloping or encasing. Since the electronic device in Baldwin is at least surrounded and/or enveloped and/or encased between the adhesive layers, Baldwin appears to teach the claimed structure.

Applicants argue that Loemker does not teach, disclose or suggest the sealing of a RFID chip using adhesive layers, or the transponder arrangement embedded between the adhesive layers and in continuous contact with the adhesive layers. Examiner respectfully disagrees. Loemker is not relied on to teach embedding the transponder between the adhesive layers and in continuous contact with the adhesive layers, as Baldwin teaches and suggests such a structure.

As set forth above, Loemker is relied on to teach that it was known in the security label art to completely enclose the security device to provide a water tight pocket to protect the security device from damage or rust, and to prevent the user from coming in direct contact with the security device. Therefore, it would have been obvious to one of ordinary skill in the security label art at the time the invention was made to form the security label of the prior art, wherein the base layer and additional layer comprise fabric layers which are sealed for completely enclosing the security device, as taught by Loemker, motivated by the desire of forming a conventional security label with materials known in the art as being predictably suitable for forming security labels which can be attached to garments and which provide a water tight pocket to protect the security device from damage or rust, and to prevent the user from coming in direct contact with the security device.

Applicants argue that Tirkkonen does not deal with the sealing of a chip within a label, and that there is no suggestion to a person of ordinary skill in the art for sealing a transponder

arrangement by means of two adhesive layers, and the transponder arrangement embedded between the adhesive layers and in continuous contact with the adhesive layers.

Regarding Applicants' arguments, Examiner respectfully disagrees. Under 35 U.S.C. 103 (a), the obviousness of an invention cannot be established by combining the teachings of the prior art references absent some teaching, suggestion, incentive, or predictability supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1395-97 (2007). This does not mean that the cited prior art references must specifically suggest making the combination. *B.F. Goodrich Co. M Aircraft Braking Systems Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996); *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)). A suggestion or motivation to combine references is an appropriate method for determining obviousness, however it is just one of a number of valid rationales for doing so. The test for obviousness is what the combined teachings of the prior art references would have suggested to those of ordinary skill in the art. *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). This test requires us to take into account not only the specific teachings of the prior art references, but also any inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

As set forth above, Baldwin teaches and suggests a structure, wherein the transponder is embedded between the adhesive layers and in continuous contact with the adhesive layers. Therefore, Applicants' arguments directed to Tirkkonen not teaching or suggesting the abovementioned structure is not commensurate in scope with the current rejection.

Additionally, Tirkkonen teaches that the identification labels may comprise an identification (RFID) circuit (*see for example* Tirkkonen, page 1 lines 8-16) and forming the label from damage caused by heat and moisture using an adhesive (Id., page 3 lines 4-13). Additionally, as shown in at least Figure 2 of Tirkkonen, the label comprises a chip within a label.

Applicants argue that the use of a foil is mandatory in combination with a label according to Tirkkonen. Examiner respectfully disagrees. Tirkkonen does not teach a foil. Therefore, Applicants' argument is not commensurate in scope with the prior art.

Applicants argue that manufacture of the antenna of the chip disclosed by Tirkkonen would not be realizable if a textile label were to be disposed as the back film, since electroconductive ink could not be printed on a textile label so as to form an antenna for a RFID chip, and therefore, Tirkkonen appears to teach away from the use of a textile upper layer. Examiner respectfully disagrees. Tirkkonen does not appear to teach away from the use of a textile upper layer, as Tirkkonen does not teach that a copper antenna cannot be used in conjunction with a textile upper layer.

Additionally, the use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain. A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. MPEP 2123. Tirkkonen is not relied on to teach electroconductive ink or electroconductive ink in combination with the prior art references.

Additionally, Applicants' arguments directed to the inability to print electroconductive ink on a textile label is not commensurate in scope with the present rejection.

Tirkkonen is relied on to teach that it was known in the identification label art to form a substantially similar identification label for use on garments, the label comprising a transponder and multiple layers of adhesive, wherein the transponder comprises a radio frequency identification device formed from copper wire (Tirkkonen, page 1 line 1 to page 4 line 20, page 4 line 36 to page 8 line 13, Figures 1-8). Therefore, it would have been obvious to one of ordinary skill in the identification label art at the time the invention was made to form the identification label of the prior art, such that the foil antenna coil of the radio frequency identification device comprises copper, as taught by Tirkkonen, motivated by the desire of forming a conventional identification label formed from metals known in the art to be predictably suitable for radio frequency identification devices.

Conclusion

The Dictionary.com Unabridged definition of "embed" is cited to show the plain meaning of the word.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PETER Y. CHOI whose telephone number is (571)272-6730. The examiner can normally be reached on Monday - Friday, 08:00 - 15:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Peter Y Choi /PYC/
Examiner, Art Unit 1786

/D. Lawrence Tarazano/
Supervisory Patent Examiner, Art Unit
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